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Peter Tong 1807 Limetree Lane Mountain View, CA 94040				
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EXAMINER				
LEIVA, FRANK M				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/734,932

**Applicant(s)**

HO ET AL.

**Examiner**

FRANK M. LEIVA

**Art Unit**

3717

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 October 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 47-51, 53, 54, 56-58, 60, 62-64, 66 and 68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47-51, 53, 54, 56-58, 60, 62-64, 66 and 68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2010 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of Prior Art References Cited (PTO-502)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/12/2010
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Acknowledgements**

1. The examiner acknowledges amendments to independent claims 47, 57, 63 in applicant's submission filed 12 October 2010.

### ***Information Disclosure Statement***

2. The information disclosure statement filed 12 October 2010 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. And it fails to comply with 37 CFR 1.98(b)(5) because it does not include a list of the relevant pages for each publication. The applicant has submitted 689 pages of non patent publications without a statement of relevancy and without pointing out the relevant pages to study. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Response to Arguments***

3. Applicant's arguments filed 12 October 2010 have been fully considered below:
4. In reference to argument directed to the objection to amendment to the specification filed 17 February 2009, in view of the support reported by the applicant the objection is withdrawn. Paragraphs [0017.01] to [0017.06] and [0048.5.2] to [0048.5.3] are to be added to the specification description.
5. In reference to argument directed to the objection to amendment to the specification filed 27 April 2010, in view of the support reported by the applicant the objection is withdrawn. Paragraphs [0064.01] to [0064.12] are to be added to the specification description

6. In regards to the argument in support of Figure 9's objection, the examiner finds no support for the newly disclosed structure included in figure 9 stating "a computer with storage." To simply state that a computer has storage is well known in the art, but to state that this storage is the one mentioned in the specification description, would completely be a new structure not previously disclosed, that is storage containing the rules and being part of the computer. The support pointed by the applicant only describes a storage holding the latest test results, and that the computer contains entertainment materials, not the storage.

7. Applicant's remarks regarding the 35 USC §112 1st paragraph rejection of claims 47, 57 and 63 as failing to comply with the written description requirement, Are not persuasive; applicant points to specification paragraph [0017.06]; which states adding a new rule, which is another rule, but to simply write generating another rule, not stating that is new, or not existing before, adds meaning, where the applicant explicitly states in [0017.06] that there is a new rule made with preference to non-new rules; nothing mentioned about a another rule.

8. Regarding the argument on page 12 of applicant's remarks; "Irrespective of whether Siefert has used rules, the above citation in Siefert has not taught or suggested (a) allowing a user to access materials related to a subject to be presented; (b) retrieving at least two rules from a group of rules, with at least one of the rules being about the subject, to help determine which additional materials to present to the user; and (c) determining based on the at least two rules, the additional materials to present to the user, after the materials accessed by the user at (a) have been presented to the user, as in applicants' claim 47, 57 and 63." The examiner points to Table 4.2, where Siefert discloses a complex set of rules with hierarchy similar to the present invention, but without calling it a conflict. When a set of rules com into a "conflict" that is the logic path has reached a level stage, the next weighted constraint has priority to decide the next step. If a previously set hierarchy is set properly, all logic decision will yield a result, or the system will halt. It is the examiner's view that the "conflict depicted by the applicant is a decision making step with a secondary branch if the first logic branch reaches an "equal" value step. In the event of Table 4.2 of Siefert, many different levels occur, including that the student has

up to almost ten times to fail at a task before an impasse and is remanded to a higher authority. But still, in Table 4.2, the assessment system evaluates when to take a review course of already learned material, not just material that has failed to learn. So the determination is based on more than two rules.

9. The examiner deems that Siefert contains more than one rule and a hierarchical conflict resolution system to determine the next lesson for the students and is inclusive with a review of already learned materials. The arguments are found not persuasive.

### ***Drawings***

10. The drawings submitted on 12 October 2010 are objected for new matter below; Fig 9 adds structure with the statement "computer with storage".

11. The drawings submitted on 27 April 2010 are objected for new matter below; Fig 9 adds structure with the statement "computer with storage".

### ***Specification***

12. The objection to amendment of the written description filed 17 February 2009 is withdrawn.

13. The objection to amendment of the written description filed 27 April 2010 is withdrawn.

### ***Specification Objection***

14. The amendment to the written description filed 12 October 2010 is objected to because of the following informalities: Top of page 13 of the amendment to the specification "[0048]" is listed as an empty line, where "[0048]" is already listed on top of page 11 with the appropriate changes. Second "[0048]" from page 13 must be deleted as a typographical error. Appropriate correction is required.

### ***Double Patenting***

15. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

16. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

17. **Claims 47, 57 and 63** are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 7 and 12 of prior **U.S. Patent No. 5,779,486**. This is a double patenting rejection.

#### ***Claim Rejections - 35 USC § 112 1<sup>st</sup> Paragraph***

18. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

19. **Claims 47, 57 and 63** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 47, 57 and 63; state "resolving the conflict by generating another rule", which is not supported by the specification and considered new matter. The specification paragraph [0017.06]; which

states adding a new rule, which is "another rule" in itself, but to simply write generating another rule, not stating that it is a new rule, or not previously existing rule, adds meaning, because "another rule" could be understood as a pre-existing rule; where the applicant explicitly states in [0017.06] that there is a new rule made with preference to non-new rules; nothing mentioned about another rule from the group of rules.

***Claim Rejections - 35 USC § 102***

**20.** The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**21. Claims 47-51, 53-54, 56-58, 60, 62-64, 66, 68 are rejected under 35 U.S.C. 102(e) as being anticipated by Siefert (US 5,904,485).**

**22. Regarding claims 47, 57 and 63;** Siefert discloses a computer-implemented method and readable memory for helping a user learn, (abstract) the method comprising:

(a) allowing the user to access materials related to a subject to be presented via a presentation device, to help the user learn, (col. 2:28-33);

(b) retrieving, from a storage device, at least two rules from a group of rules, with at least one rule being about the subject (table 4.2); to help determine which additional materials to present to the user, (12:59-13:17), the existence of the rules to be followed, implies inherency for the retrieval and use of them;

(c.) determining, based on at least two rules the additional materials to present to the user, after the materials accessed by the user at (a) have been presented to the user, (15:52-16:20);

selecting least some of the materials accessed by the user at (a) for presentation to the user for a further time so that the user's memory on the materials can be refreshed, (Table 4.2, and col. 17:24-30), "Scheduling occasions for spaced reviews".

wherein (c.) includes determining, by a computing device, whether the at least two rules have a conflict in view of an assessment of the user, and, if there is a conflict, resolving the conflict by generating another rule that is added to the group of rules to help determine the additional materials to present to the user, the computing device being coupled to the storage device, and wherein the at least two rules have a conflict in view of an assessment when a consequence of at least two rules differs from the assessment, (col. 7:28-8:62), the CLS includes many rules some of which hierarchical in terms of sequence of lessons, but may be overridden by other rules according to the students profile (standing) or nature of the lessons, the system is self adjusted to the specific student.

**23. Regarding claim 48;** Siefert discloses wherein at (d) the selecting of at least some of the materials accessed by the user at (a) for presentation to the user for the further time occurs after the additional materials determined at (c.) have been presented to the user, (col. 17:24-31), where spaced reviews are constantly being assigned.

**24. Regarding claim 49;** Siefert discloses wherein the method further comprises having at least some of the accessed materials transmitted via a network to the presentation device to be presented to the user, and wherein the network includes a private network and a public network, (col. 2:28-37).

**25. Regarding claims 50, 58 and 64;** Siefert further discloses wherein the at least some of the materials accessed by the user at (a) are selected at (d) for presentation to the user for the further time depending on a time elapsed from when the user accesses



the materials at (a), (table 4.2 and col. 17:24-31), scheduled spaced reviews, meaning timed reviews from last studied.

**26. Regarding claim 51;** Siefert discloses wherein the at least some of the materials accessed by the user at (a) can be repeatedly selected for presentation to the user, (col. 14:59-67), but if the time elapsed is more than a predetermined duration of time, the at least some of the materials accessed by the user at (a) are no longer selected, (col. 9:61-67), system will no longer repeat subject after all available tries have been presented, will be force to select subject expert.

**27. Regarding claim 53;** Siefert discloses wherein the at least some of the materials accessed by the user at (a) can be repeatedly selected for presentation to the user, (col. 14:59-67).

**28. Regarding claims 54, 60 and 68;** Siefert discloses wherein the additional materials determined to be presented to the user at (c.), also relate to the subject, (col. 8:20-32), where the lessons being of the same subject (calculus).

**29. Regarding claims 56, 62 and 66;** Siefert discloses wherein resolving the conflict between the at least two rules involves favoring one of the at least two rules over another one of the at least two rules, (col. 7:28-8:62), the CLS includes many rules some of which hierarchical in terms of sequence of lessons, but may be overridden by other rules according to the students profile (standing) or nature of the lessons, the system is self adjusted to the specific student.

***Examiner's Note***

**30.** The referenced citations made in the rejection(s) above are intended to exemplify areas in the prior art document(s) in which the examiner believed are the most relevant to the claimed subject matter. However, it is incumbent upon the applicant to analyze

the prior art document(s) in its/their entirety since other areas of the document(s) may be relied upon at a later time to substantiate examiner's rationale of record. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). However, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed ...." *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK M. LEIVA whose telephone number is (571) 272-2460. The examiner can normally be reached on M-F 11:00 am - 4:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Melba Bumgarner can be reached on (571) 272-4709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melba Bumgarner/  
Supervisory Patent Examiner, Art Unit 3717

/F. M. L. /  
Examiner, Art Unit 3717  
12/27/2010